UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,549	10/17/2000	Oleg B. Rashkovskiy	BKA.0006US	2613

21906	7590	10/20/2005

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EXAMINER
BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/690,549	RASHKOVSKIY, OLEG B.
		Examiner	Art Unit	
		Reuben M. Brown	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 May 2005</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>47-57</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>47-57</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/6/05</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)   Office Action Summary   Part of Paper No./Mail Date 20051018

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to the claims have been considered but are moot in

view of the new ground(s) of rejection.

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 47-50 & 54-57 are rejected under 35 U.S.C. 102(e) as being anticipated by

Rosser, (U.S. Pat # 6,446,261).

Considering claim 47, the claimed 'receiver to receive content, an advertisement and

update instructions', reads on the operations of the set-top device 44 in Rosser, which receives

audio/video, advertisements and insertion information; see Fig. 1; Fig. 2; col. 7, lines 20-58.

'update instructions' are broad enough to read on the LVIS information, such as

information attached to a proposed insert, which are sent from the headend and are used to

determine which advertisement(s) will be inserted in the content, using the viewer usage profile

data 120, col. 7, lines 45-58.

'a cache, coupled to the receiver, to store the content and the advertisement', is met by

the audio and video storage unit 152, which stores audio/video data, including advertisements,

col. 13, lines 11-35 & col. 14, lines 44-48.

'a shell, in the receiver, to find a place to insert the advertisement in the cached content

before the cached content is to be output for display, such that the receiver receives an update fro

the advertisement and automatically replaces the advertisement using the instructions', reads on

the operation in Rosser of inserting different advertisements in different video, based upon the

attached category code, compared at least to the viewer usage profile data 120, col. 7, lines 45-

58.

Considering claim 48, the claimed 'receiver to receive update with a pointer, such that the

receiver uses the pointer to store the update at a location', is inherently included in Rosser, since

the LVIS information is specific to a particular program.

Considering claims 49-50, the claimed 'marker', reads on the discussion in Rosser that

the insertions are placed at particular points to appear seamless, col. 7, lines 40-45 & col. 14,

lines 52-67.

Considering claims 54-55, the advertisement information in Rosser are updated, as

periodically as the system downloads new commercial information, see Abstract; col. 7, lines 50-

58.

Considering claim 57, Rosser discloses a set-top device 44.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser, in

view of Khoo, (U.S. Pat # 6,434,747).

Considering claims 51-53, the instant claims are directed to storing a list of

advertisements, in order to determine whether a particular advertisement has been already stored.

However, even though Rosser clearly is enabled to store multiple advertisements, the reference

does not explicitly discuss the use of a list. Nevertheless Khoo, which is in the same filed of

endeavor, discloses transmitting a list of customized media that is stored on a user terminal,

Abstract;; 5, lines 35-50 & col. 8, lines 15-25. It would have been obvious for one of ordinary

skill in the art at the time the invention was made, to modify Rosser with the teaching of Khoo

providing a list of customized media to a user terminal, at least for the desirable purpose of

allowing the user to view the instant items that are stored and make modifications, as taught by

Khoo, col. 5, lines 41-52 & col. 11, lines 1-15.

Considering claim 54, the claimed feature of 'uploading the list to a remote server', reads

on Khoo, which teaches that when the user modifies the list, that the user personalized data is

updated, col. 11, lines 10-15. However, Khoo does specifically state that the updated

personalized data is transmitted back to the server. Official Notice is taken that at the time the

invention was made, it was well known to store user-personalized data a server. It would have

been obvious for one of ordinary skill in the art at the time the invention was made, to modify the

combination of Rosser & Khoo with the well known feature of transmitting user-personalized

data upstream to be stored at a remote storage unit, at least for the desirable advantage of

allowing in the user-personalized data to be more easily shared by a wider variety of vendors.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

A)   Hite   Teaches storing advertisement info at a terminal device.

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any response to this action should be mailed to:

> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450
> www.uspto.gov

> **or faxed to:**
> (571) 273-8300, (for formal communications intended for entry)
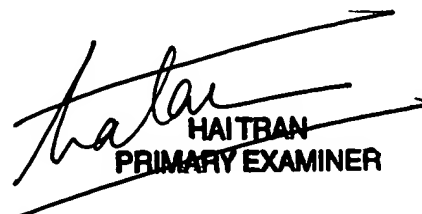> **Or:**
>> (571) 273-7290 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

HAI TRAN
PRIMARY EXAMINER